

**REMARKS**

Reconsideration of this Application is respectfully requested in view of the following remarks. Claims 21 and 23-38 are pending in this Application. For the reasons set forth below, Applicant respectfully submits that all claims pending herein are in condition for Allowance.

In the Office Action:

- Claims 21, 23, 28-30 and 33-35 were rejected under 35 U.S.C. §102(e) as anticipated by U.S. Patent No. 6,694,515 to De Bot et al. ("De Bot").
- Claims 24-27, 31-32 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over De Bot in view of U.S. Patent Application Publication No. 2002/0090087 to Tamura et al. ("Tamura").
- Claims 36 and 37 were rejected under 35 U.S.C. §103(a) as being unpatentable for obviousness over De Bot in view of U.S. Patent No. 6,418,424 to Hoffberg et al. ("Hoffberg").

Applicant respectfully traverses these rejections, for the reasons set forth below.

**Anticipation Rejection over De Bot**

Claims 21, 23, 28-30 and 33-35 were rejected under 35 U.S.C. § 102(e) as allegedly anticipated by De Bot. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

The presently claimed invention recites systems and methods for recording a particular program, comprising: (a) receiving program information comprising a plurality of program events, wherein each program event is associated with a set of available content streams; (b) providing a user option to select a desired subset of the set of available content streams associated with the particular program event for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams; and (c) receiving a user command or user input indicating the desired subset of available content streams

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for recording. *See* claims 21, 28 and 33, and their respective dependent claims. Claim 21 further requires that a storage device be configured to store the program information, and that a processor is configured to provide the user option and receive user input. *See* claim 21.

The Office contends that De Bot teaches a storage device to record specific content information. Office Action at pages 2-3. In particular, the Office contends that De Bot teaches the claimed systems and methods because De Bot allegedly discloses “content information, in TV signal, includes audio of the news, video of the news, and data information of the news” and that “based on the user’s selection, for example sports report or MP3 song of a program, receiver only receives either sports report or audio of the program.” Office Action at page 3. Applicant respectfully disagrees.

Contrary to the assertions in the Office Action, De Bot does not teach the claimed systems or methods, either in the cited columns or elsewhere. De Bot teaches a system that stores content information, such as “data (e.g., news headlines, weather reports, stock market data or sports results) and/or audio (e.g., songs, news headlines, sports reports, voice mails, spoken books) and/or video (e.g., news, sports, movies, video clips).” De Bot at col. 1 line 66 through col. 2 line 3. The system:

generates user preference information 21 [which] indicates the content information 13 that is preferred by the user [and] transmitter 10 may use this user preference information 21 to include content information 13 into the signal 11, which content information is preferred by the user. For instance, if the user always selects sports reports from the stored content information, the user preference information 21 will indicate this and the transmitter 10 may include more sports reports into the signal 11.

De Bot at col. 4 lines 4-16.

The Office apparently equates the types of content information in De Bot with the claimed available content streams, for example by pointing out that the content information “includes audio of the news, video of the news, and data information of the news.” Office Action at page 3. This equation is further supported by the Office’s argument that a user’s selection of sports programs is the same as the claimed receipt of user input indicating the

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desired subset of available content streams for recording. Office Action at page 3. However, the Office fails to explain what elements of De Bot equate to the other claim limitations, and the Office's comparison breaks down at this point.

The Office points to a user's selection of "sports reports" as an alleged selection of a desired subset of available content streams, and states that once a user has selected a sports report, that the receiver receives *only* that sports report. Office Action at page 3. This analysis is incorrect. De Bot explains that "if the user always selects sports reports ... the transmitter 10 *may include more* sports reports into the signal 11." De Bot at col. 4, lines 13-16 (emphasis added). Thus, even if the Office were correct that a "sports report" is a desired subset of available content streams, the system of De Bot does not function in the manner required by the claims, because De Bot does not record *only* the selected subset ("the sports report"). Instead, the system of De Bot functions to *maybe* include *more* subsets like the selected subset into the signal. Moreover, if the sports reports are an available content stream, then what is the program event with which it is associated?

Following the Office's logic, if a user's selection of Super Bowl XXXVI for recording is equivalent to user input indicating a desired subset of available content streams, then the Super Bowl XXXVI is the desired subset of the set of available content streams associated with the particular program event. What then are the other available content streams that are not stored? And what is the particular program event with which they are associated? What is the program information? What are the other sets of available content streams associated with the other programs in the plurality of programs? Further, De Bot indicates (at col. 4, lines 13-16) that if a user always selects sports reports, the system may include more sports reports into the signal. In the case of a user selecting Super Bowl XXXVI, what more is included? More (multiple) copies of Super Bowl XXXVI? More Super Bowl, e.g., Super Bowl XXXVII? More football games? All of these questions remain unanswered by the Office's rejection, and therefore the rejection is improper because it fails to show that each and every limitation of the claimed invention is taught by the art.

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As described above, the presently claimed systems and methods are directed at permitting a user to select a subset of the “available content streams” associated with a particular program event for recording. Each program event is associated with a separate set of available content streams. The selection of the desired subset prevents unnecessary content stream recording and reduces the storage requirements. For example, if a user of the claimed system wanted to record a live sporting event such as Super Bowl XXXVI, the user is provided with the option to select available content streams, for example an English audio stream, a Spanish audio stream, a regular definition video stream, and a high definition video stream. The system provides a user option to select a desired subset of the available content streams while excluding at least one of the content streams, and also receives user input indicating the desired subset. Depending on the user’s preferences, the desired subset can vary. For example, a Spanish-speaking user might select the Spanish audio stream and the high definition video stream, and an English-speaking user might select the English audio stream and the regular definition video stream. The selection of the desired subset prevents unnecessary content stream recording and reduces the storage requirements.

Thus, as presently claimed, a user selects a subset of the available content streams associated with a particular program event for recording. The De Bot system does not teach, disclose or suggest this. De Bot teaches recording an entire program (e.g., a movie, sports report, or MP3 song), and does not teach the recording of only certain content streams associated with a program event. Thus, the De Bot system would record the entire set of content streams associated with Super Bowl XXXVI, including the English audio stream, a Spanish audio stream, a regular definition video stream, and a high definition video stream. Thus, for the same program event, the user of the De Bot system would have increased storage requirements, because unnecessary content streams have been recorded.

De Bot thus fails to teach receiving program information comprising a plurality of program events, wherein *each program event is associated with a set of available content streams*, providing a *user option to select a desired subset of the set of available content*

streams associated with the particular program event for recording, wherein the subset excludes at least one available content stream from the associated set of available content streams, and receiving a user command or user input indicating the desired subset of available content streams for recording, as required by all of the pending claims.

For the reasons stated above, De Bot does not teach all of the claimed limitations of the present invention, and Applicant respectfully requests that the rejection be withdrawn.

#### **Obviousness Rejection over De Bot in view of Tamura**

Claims 24-27, 31-32 and 38 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over De Bot in view of Tamura. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, De Bot is deficient as a primary reference, because it fails to teach or suggest each and every limitation of the independent claims. De Bot does not teach or suggest a user selecting some of the “available content streams” associated with a particular program event for recording as claimed in the present invention. Tamura’s alleged teaching of a descrambler fails to supplement the deficiencies of De Bot as a primary reference.

In addition, a prima facie case of obviousness has not been established because the Office has not provided any support for the conclusion that there existed at the time of the invention an apparent reason to modify the device of De Bot in the manner claimed. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 82 USPQ2d 1385, 1396 (2007); *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also MPEP § 2141. The Office provides no explanation of why one would modify De Bot with Tamura, because Tamura’s provision of a descrambler would not provide any benefit to the De Bot system, which lacks any scrambled signals or indeed any motivation for scrambling or descrambling signals. Nor does the Office explain how to modify De Bot with

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Tamura, or how such a modification would achieve the claimed invention. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicant respectfully requests that the rejection be withdrawn.

**Obviousness Rejection over De Bot in view of Hoffberg**

Claims 36 and 37 were rejected under 35 U.S.C. § 103(a) as allegedly obvious over De Bot in view of Hoffberg. To the extent this rejection might still be applied to claims presently pending in this Application, it is respectfully traversed, and reconsideration is requested.

As previously discussed, De Bot is deficient as a primary reference, because it fails to teach or suggest each and every limitation of the independent claims. De Bot does not teach or suggest a user selecting some of the “available content streams” associated with a particular program event for recording as claimed in the present invention. Hoffberg’s alleged teaching of a modulator fails to supplement the deficiencies of De Bot as a primary reference.

In addition, a prima facie case of obviousness has not been established because the Office has not provided any support for the conclusion that there existed at the time of the invention an apparent reason to modify the device of De Bot in the manner claimed. Rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. See *KSR Int’l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1740-41, 82 USPQ2d 82 USPQ2d 1385, 1396 (2007); *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also MPEP § 2141. The Office provides no explanation of why one would modify De Bot with Hoffberg, because Hoffberg’s provision of a modulator would not provide any benefit to the De Bot system, which lacks any motivation for modulating signals.

The Office cites to Hoffberg at columns 60 and 95, but these passages merely disclose an amplifier/demodulator (element 2006) in the context of “cataloging and indexing of the contents of a storage medium” (at col. 59 line 15 through col. 61 line 62) and a “programmable environmental controller” (i.e., a thermostat) (at col. 93 line 32 through col. 96 line 63), and fail to teach or suggest using a modulator in a system such as De Bot. Nor does the Office explain

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how to modify De Bot with Hoffberg, or how such a modification would achieve the claimed invention. Hence, the cited references taken alone or in combination do not teach, suggest, or make obvious the present invention, and Applicant respectfully requests that the rejection be withdrawn.

In view of the foregoing, all of the claims in this case are believed to be in condition for allowance. Should the Examiner have any questions or determine that any further action is desirable to place this Application in even better condition for issue, the Examiner is encouraged to telephone Applicant's undersigned representative.

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